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recording the contents of the selected ones of the documents; and
collating the selected documents according to a predetermined order of collation to form
said single printable document, said collating comprising arranging at least one display page
according to a size of each selected document, wherein the printable document is reproducible at
least by printing.--

REMARKS

Summary

Independent Claims 1, 16, 27, 28, 29, 31, and 38-41 recite at least one feature not disclosed or suggested by the patents to Judson, Yoda, Nielsen, and Feliciano, et al. Therefore, should these claims be allowed over this art?

Status of the claims

Claims 1-24 and 26-41 are pending in the application. Claim 1 has been amended. Claims 39-41 have been added. Claims 1, 16, 27, 28, 29, 31, and 38-41 are independent.

Requested action

Applicants respectfully request the Office to reconsider and withdraw the outstanding rejections in view of the foregoing amendment and the following remarks.

Errors in Office Action

The Office Action incorrectly acknowledges a claim to priority; no claim to priority was filed. The Office Action also states in paragraph 5 that the rejection of Claims 15 and 24 has

been withdrawn over the patents to Feliciano and Nielson, when these claims had never been rejected over this art, except in the present Office Action. Finally paragraphs 3 and 11 of the Office Action incorrectly refer to the patents to Yoda and Judson by the same patent number. Applicants respectfully request that these errors be corrected in the next Office Action.

Claim objection

The Office Action objects to Claim 37 because the word “of” is missing between “fill each” and “the column”. In response, Applicants submit that this informality was corrected in the December 12, 2000 Amendment.

Substantive rejections

Claims 1-6, 8-14, 16-23, 27-29, 30, 31, and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the patents to Judson and Yoda, both previously cited, in view of U.S. Patent No. 5,761,436 (Nielsen) and U.S. Patent No. 6,052,730 (Feliciano, et al.). Claims 15 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the patents to Judson, Yoda, Nielsen, and Feliciano, et al., in view of the publication to Brown. Claims 7, 26, and 32-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the patents Judson, Yoda, Nielsen, and Feliciano, et al., in view of the patent to Hayashi, et al.

Response to substantive rejections

In response, while not conceding the propriety of the rejections, independent Claim 1 has been amended. Applicants submit that as amended, Claim 1 is allowable for the following reasons.

A. Claim 1

Claim 1 relates to a method of forming a single printable document by collating a plurality of hyper-text documents. The method comprises the steps of: (a) monitoring a user's access patterns to the hyper-text documents; (b) from the monitoring, accessing the hyper-text documents including structure information of the accessed hyper-text documents; (c) compiling a list of the accessed hyper-text documents using the structure information; and (d) formatting the list into the printable document comprising each hyper-text document selected from the list.

Claim 1 has been amended to recite that step (d) formats the list into the printable document comprising each hyper-text document selected from the list using the structure information.

This arrangement permits the formation of a single printable document comprising hyper-text documents selected from a list of user-accessed hyper-text documents compiled from monitoring a user's access patterns to the hyper-text documents. Thus, the user's mere browsing of a computer network can be used to identify (i.e., form a list) hitherto unrelated documents and form a single printable document comprising selected hyper-text documents from that list. These listed hyper-text documents may be sourced from within a homepage, and thus include their own internal linking or may be entirely disparate, as can be seen from the print list 61 of Figure 5, the corresponding functions of which are described at page 7, line 26 through page 8, line 21 of the specification.

In summary, Claim 1 explains how a single printable document, comprising selected hyper-text documents, is formed (e.g., by monitoring a user's hyper-text-document access patterns, accessing the monitored documents, compiling a list of the accessed documents using

the document structure information, and formatting the list using the structure information into a printable document).

In contrast, none of the applied art teaches or suggests the concepts of compiling a list of the accessed hyper-text documents using the structure information or formatting the list into the printable document comprising each hyper-text document selected from the list, as recited by amended Claim 1.

The Office Action cites the Nielsen patent to teach the compiling step, quoting a portion thereof that states “The information stored in each of the elements 501 is illustrated by a plurality of history data structures....a ‘Page Title field ‘517.... comprising the title for the hypernode”. But the Nielsen patent is directed to mechanisms by which the length of the history record may be reduced to enable ease of searching by the web-browser user. Therefore, Nielsen’s history list is used for allowing a user to backtrack to a previously visited page accessed through a hyperlink. The title page field referred to by the Nielsen patent is merely the text title of the web page. The title is not indicative of the structure of the document and relates only to a small portion of the content of the document. Therefore, this patent does not disclose or suggest the step of compiling a list of accessed hyper-text documents using the structure information of the documents, as recited by amended Claim 1.

The Office Action cites the Feliciano, et al. to show the formatting step, quoting this patent to “provide automatic lists of URLs that the user has visited....sent as HTML documents to a client”. But this patent’s list is used for showing the relationship between the URLs visited. In addition, at column 7, lines 45-47, this patent notes that the database can “provide automatic lists of URLs that the user has visited, sorted in various ways”. The Feliciano, et al. patent does not disclose or suggest that its automatic lists contain the relevant web page corresponding to the

URLs in the list. Thus, this patent does not disclose or suggest the concept of formatting a list of accessed hyper-text documents using structure information of the documents into a printable document comprising each hyper-text document selected from the list, as recited by amended Claim 1.

The failure of the cited art to disclose or suggest either the compiling step or the formatting step of amended Claim 1 proves fatal to establishing a prima facie case of obviousness against amended Claim 1, since MPEP § 2142 states that:

To establish a prima facie case of obviousness... the prior art reference (or references when combined) must teach or suggest all the claim limitations.

For this reason, amended Claim 1 is allowable over the cited art.

B. Independent Claims 16, 27-29, 31, and 38.

Although independent Claims 16, 27, 28, 29, 31, and 38 are directed to different inventions than amended Claim 1, they recite similar features and are allowable for similar reasons.

Claim 16 relates to a method of forming a single printable document by collating a plurality of hyper-text documents comprising the steps of accessing the hyper-text documents including corresponding structure information and collating and formatting accessed hyper-text documents using the structure information and at least a predetermined printable document format to form a printable document in which the accessed hyper-text documents are contiguously arranged therein over at least one printable page. Since the Office Action has not cited any reference teaching the step of collating and formatting accessed hyper-text documents using the structure information and at least a predetermined printable document format to form a

printable document in which the accessed hyper-text documents are contiguously arranged therein over at least one printable page, Claim 16 is allowable under MPEP § 2142.

Claim 27 relates to a computer implemented method for forming a single printable document by collating a plurality of documents obtained from a plurality of sources comprising, in part, the step of collating selected documents according to a predetermined order of collating to form a printable document, the collating comprising arranging at least one display page according to a size of each selected document based upon corresponding structure information wherein the printable document is reproducible by at least by printing. Since the Office Action does not allege that any reference discloses or suggests the step of arranging at least one display page according to a size of each selected document based upon corresponding structure information, wherein a printable document is reproducible by at least by printing, Claim 27 is allowable over the art.

Claim 28 recites a computer system comprising, in part, means for monitoring access to documents via a resource locator and compiling a list of accessed ones of the documents, the list including corresponding links and structure information pertaining to each accessed document, and means for collating the list into a selected order and for formatting the accessed documents within the list into a single printable document having at least components corresponding to the accessed documents arranged in the selected order. Since the Office Action does not allege that any reference discloses or suggests these steps, and particularly the compiling of a list including structure information of each accessed document, Claim 28 is allowable over the cited art.

Claim 29 relates to a computer readable medium including instruction modules comprising, in part a collating module for collating user selective ones of documents from a compiled list into a single printable document in which each selected document is formatted

according to structure information derived from monitoring browsing operations and a printing module for causing a printing of the single printable document thereby causing hard copy reproduction of the single printable document and the selected documents. Since the Office Action does not allege that any of the cited art discloses or suggests formatting each document according to structure information derived during monitoring, Claim 29 is allowable over the cited art.

Claim 31 relates to a computer program product having a computer readable medium having a computer program recorded thereon for forming a printable document by collating a plurality of hyper-text documents, comprising, in part, means for compiling a list of selected ones of the hyper-text documents using structure information of the documents and means for formatting the list into a printable document comprising the selected ones of the accessed hyper-text documents. Since the Office Action does not allege that the cited art discloses or suggests means for compiling a list of selected ones of the hyper-text documents using structure information of the documents, Claim 31 is allowable over the cited art.

Claim 38 relates to a computer implemented program for forming a single printable document by collating a plurality of hyper-text document, the method comprising, in part, the steps of fetching hyper-text documents accessed by a first application including corresponding structure information thereof and creating a single formatted printable document version of the accessed hyper-text documents. Since the Office Action does not allege that any of the cited art discloses or suggests steps of fetching hyper-text documents accessed by a first application including corresponding structure information thereof and creating a single formatted printable document version of the accessed hyper-text documents, Claim 38 is allowable over the cited art.

C. New independent Claims 39-41

New independent Claim 39 recites a method of forming a single printable document by collating a plurality of documents, the method comprising the steps of monitoring a user's access patterns to the documents, from the monitoring, compiling a list of the accessed documents in response to monitoring of the user's access to the document, displaying the list of the accessed documents for enabling selection of at least one of the documents to be printed, and formatting each document selected from the list into the single printable document.

Independent Claim 40 relates to a method of forming a single printable document by collating a plurality of documents, the method comprising steps of accessing the documents, compiling a list of the accessed documents in response to monitoring of user's access to the document, displaying a list of the accessed documents for enabling selection of at least one of the documents to be printed, and collating the accessed documents selected from the list to form the single printable document in which the accessed documents selected from the list are contiguously arranged therein over at least one printable page thereof.

Independent Claim 41 relates to a computer implemented method for forming a single printable document by collating a plurality of documents obtained from a plurality of sources, the method comprising the steps of monitoring accesses to the documents in sequence, compiling a list of the accessed documents in response to monitoring of a user's access to the document, displaying a list of the accessed documents for enabling selection of at least one of the documents to be printed, recording the contents of the selected ones of the documents, and collating the selected documents according to a predetermined order of collation to form said single printable document, said collating comprising arranging at least one display page

according to a size of each selected document, wherein the printable document is reproducible at least by printing.

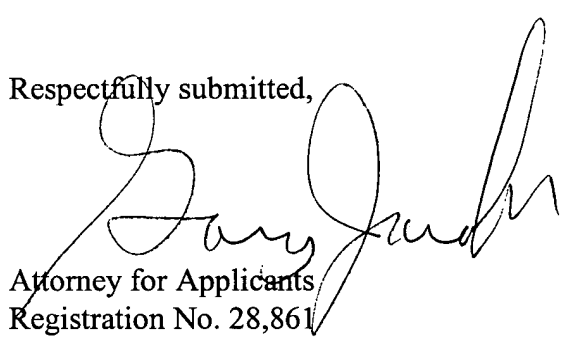
None of the cited art is understood to disclose this combination of features. Therefore, these claims are allowable over the cited art.

The dependent claims are allowable for the reasons given with respect to the independent claims and because they recite features which are patentable in their own right. Individual consideration of the dependent claims is respectfully solicited.

In view of the above amendments and remarks, the claims are now in allowable form. Therefore, early passage to issue is respectfully solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,


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VERSION WITH MARKINGS TO SHOW CHANGES MADE TO THE CLAIM

1. (Three Times Amended) A method of forming a single printable document by collating a plurality of hyper-text documents, said method comprising the steps of:

(a) monitoring a user's access patterns to the hyper-text documents;

(b) from said monitoring, accessing the hyper-text documents including structure information of the accessed hyper-text documents;

(c) compiling a list of the accessed hyper-text documents using the structure information;

and

(d) formatting the list using the structure information into the printable document comprising each hyper-text document selected from the list.